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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,158	08/25/2003	Kenneth MC Cheung	UHK.118XT	3550
23557 7590 03/31/2010 SALIWANCHIK LLOYD & SALIWANCHIK A PROFESSIONAL ASSOCIATION PO Box 142950 GAINESVILLE, FL 32614				
EXAMINER BECCIA, CHRISTOPHER J				
ART UNIT 3775		PAPER NUMBER		
NOTIFICATION DATE 03/31/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

euspto@slspatents.com

### Office Action Summary

**Application No.**

10/648,158

**Applicant(s)**

CHEUNG ET AL.

**Examiner**

CHRISTOPHER BECCIA

**Art Unit**

3775

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-22, 28, 29, 34-39 and 41-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-22, 28, 29, 34-39 and 41-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/25/03 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/9/10
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 26, 2009 has been entered.

### ***Response to Arguments***

1. Applicant's arguments with respect to Claims 20-22, 28, 29, 34-39, 41-43, and 45-52 have been considered but are moot in view of the new ground(s) of rejection. Please direct attention to new rejection below, specifically reference Justis. Examiner has attempted to provide more specificity as to where each element of the claim is found in the reference as well.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 20-22, 28, 29, 34-39, 41-43, and 45-52** are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,761,719 to *Justis et al.*

As to **Claims 20, 36, 37, and 46**, *Justis* discloses a method for correcting spinal deformities in a human patient (Col. 2, Lines 37-41), the method comprising:

providing a correction device comprising an elongated rod (302), the elongated rod having a pre-contoured shape of a normal degree of kyphosis and lordosis of at least a portion of the patient's spine (Col. 12, Lines 16-19), the elongated rod comprising a superelastic material having a transition temperature ( $A_f$ ) within the range of human body temperature (Col. 12, Lines 1-26);

deforming the elongated rod to conform to a deformed portion of the patient's spine (Col. 12, Lines 22-26);

mounting the deformed elongated rod to the patient's spine including the deformed portion (Col. 12, Lines 22-38), whereby the deformed elongated rod is capable of applying a correction force having a predetermined amount to correct the deformed portion of the patient's spine, the correction force being generated by the superelastic material at the patient's body temperature and in an austenite phase of the superelastic material (Col. 12, Lines 16-38); and

maintaining the correction force at the predetermined amount until the deformed elongated rod resumes the pre-contoured shape to fully or substantially fully correct the spinal deformities (Col. 12, Lines 38-67 – Col. 13, Lines 1-21);

wherein the correction force is constant or substantially constant and controllable during spinal deformity correction (Col. 13, Lines 5-17), and wherein the spinal deformity is a deformity of scoliosis, kyphosis, or lordosis (Col. 2, Lines 10-31).

As to **Claims 21 and 38**, *Justis* discloses a method wherein the predetermined amount of the correction force can be adjusted (Col. 13, Lines 17-20).

As to **Claims 22 and 39**, *Justis* discloses a method wherein the correction force is activated during the spine correction surgery (Col. 12, Lines 16-38).

As to **Claim 28**, *Justis* discloses a method wherein the correction force is applied to the deformed spine portion from the anterior aspect of the spine (Col. 11, Lines 47-51).

As to **Claim 29**, *Justis* discloses a method wherein the correction force is applied to the deformed spine portion from the posterior aspect of the spine (Col. 11, Lines 47-51).

As to **Claims 34 and 41**, *Justis* discloses a method further comprising limiting the correction device from movement (Col. 12, Lines 61-66).

As to **Claims 35 and 42**, *Justis* discloses a method further comprising limiting the correction device from a rotation movement (Col. 12, Lines 46-50 and Col. 12, Lines 61-66).

As to **Claim 43**, *Justis* discloses a method further comprising providing an anchor member (304) for mounting the supporting member to the deformed spine portion (Col. 11, Lines 52-67).

As to **Claims 47-49**, *Justis* discloses a method wherein the correction force is not remotely activated (Col. 12, Lines 39-60).

As to **Claim 50**, *Justis* discloses a method wherein deforming the elongated rod comprising bending the elongated member to conform to the deformed portion of the patient's spine (Col. 12, Lines 15-38).

As to **Claim 51**, *Justis* discloses a method wherein applying the correction force comprising bending the supporting member to conform to the deformed portion of the patient's spine and mounting the bent supporting member to the patient's spine including the deformed portion (Col. 12, Lines 15-38).

As to **Claim 52**, *Justis* discloses a method wherein applying a supporting member comprising bending the supporting member to conform to the deformed spinal portion of the recipient and mounting the bent supporting member to the recipient's spine including the deformed spinal portion (Col. 12, Lines 15-38)..

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claim 44** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,761,719 to *Justis et al.* in view of U.S. Patent No. 6,296,643 to *Hopf et al.*

As to **Claim 44**, *Justis* discloses the claimed invention except for wherein the anchor member comprises a superelastic material.

*Hopf* discloses a spine stabilization device wherein the anchor member comprises a superelastic material (Col. 3, Lines 40-46, Col. 4, Lines 47-61, Col. 6, Lines 5-19) in order to provide fusionless correction of scoliosis, using a compatible biomaterial for implantation into the spine (Col. 6, Lines 5-11, Col. 3, Lines 40-46).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of providing a substantially constant force for correcting spinal deformities of *Justis* with the anchor members comprised of superelastic material of *Hopf* in order to provide fusionless correction of scoliosis, using a compatible biomaterial for implantation into the spine.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER BECCIA whose telephone number is (571)270-7391. The examiner can normally be reached on M-F 7:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER BECCIA/  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
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